

## **REMARKS**

### **I. STATUS OF CLAIMS**

Without prejudice, the claims have been amended to clarify the claimed invention. Specifically, Claim 1 has been amended to indicate that (1) the system comprises a user device interface such that the controller can receive user input, (2) the interactive information is content from the web as defined in the specification (¶0012), and (3) the display of the interactive and broadcast content is formatted according to user preferences. Independent Claim 16 has also been amended to indicate that the display of the interactive and broadcast content is formatted according to user preferences. Finally, miscellaneous dependent claims have been amended to make them consistent with the independent claims.

### **II. CLAIM OBJECTIONS**

The Examiner objected to claims 1 and 2 because it was unclear which “user selectable element” applicant was referring to as two user selectable elements were recited in lines 8 and 10 of claim 1. In reply, Applicants have amended claim 1 to eliminate this language, thereby rendering the objection moot.

### **III. PRIOR ART REJECTIONS**

The Examiner rejected claims 1-3, 5-7 and 9-10, 13 and 21-22 under 35 U.S.C. §102(e) as being anticipated by Shoff et al. (U.S. Patent No. 6,240,555). Specifically, with respect to claim 9, the Examiner states “that Shoff further teaches said user selectable element includes a control button for selecting a preference. Said preference being used to determine how said broadcast information is presented in relation to said interactive information.” In reply, Applicants respectfully submit that Shoff does not disclose the claimed invention as amended.

#### **A. Shoff fails to disclose formatting the interactive and broadcast content according to user preferences.**

It is well established in U.S. patent law that, to anticipate a claim, each and every element of the claim must be disclosed by the reference. Here, Shoff fails to disclose

formatting the interactive and broadcast content according to the user preferences. Although the Examiner states that a soft button is used to select a preference and that that preference is used "to determine how said broadcast information is presented in relationship to said interactive information," this is a mischaracterization. The text to which the Examiner refers does not relate to the display of the interactive content *vis a vis* broadcast content, but rather to the display of a *menu* of interactive content to broadcast content . Specifically, the text states as follows:

Soft button 217 is an access/classified toggle which allows selection of one of two levels of interactivity. "Access" serves as a default mode of interactivity which contains the main menu functionality. The screen of FIG. 8b is an example of the access mode of interactivity. A voice-over narrative announces the mode when selected by button 217. Once in the access mode, the broadcast video stream is shrunk to fit within the smaller program boundary 210 to accommodate the main menu graphics. The alternate mode of interactivity, or "classified" mode, contains time-linked contextual information to provide a second tier of information. FIG. 8c, shown below, is an example of the classified mode of interactivity.

(Col. 11, ll. 12-42.) Therefore, when in the "access" mode, a *menu* of supplemental content is displayed. The menu, however, is not interactive information obtained from the web as claimed—it is merely a menu providing "access" to the interactive information. "Interactive information" as used in the claimed invention is displayed only in the "classified" mode in Shoff. There is no disclosure in Shoff, however, that the interactive and broadcast content can be formatted according to the user preferences in this mode. Therefore, Applicants respectfully submit that because the interactive content and the broadcast content are not formatted according to user preferences, Shoff fails to anticipate the claimed invention.

**B. Not only does Shoff fail to anticipate the claimed invention, but also there is no motivation to modify Shoff in accordance with the claimed invention.**

There is no motivation or reason to modify Shoff such that the broadcast and interactive content is formatted according to user preferences. To the contrary, modifying Shoff such that the broadcast and interactive content is formatted according to user preferences would *undermine* the invention of Shoff. It is well established in U.S. Patent law that there can be no reason or motivation to modify a reference if such modification would undermine the invention of the reference. Here, Shoff states throughout the specification, and

even claims, that the target resource contains the display instructions which describe how the interactive content and the broadcast program are to appear in relation to one another when displayed on the television monitor. Specifically, as set forth in Shoff's Summary of the Invention:

The target resource also contains display layout instructions prescribing how the supplemental content and the video content program are to appear in relation to one another when displayed on the television or monitor. When the data from the target resource is downloaded to the viewer computing unit, the processor is responsive to the layout instructions obtained from the target resource to display the supplemental content concurrently with the video content program. Embedding the layout instructions in the supplemental content advantageously returns control of the presentation to the content developers. The developers can now arrange the data and video in any manner they choose. The developers are not restricted to specific fixed panes, as in the prior art.

(Col. 3, ll. 38-52) Therefore, Shoff states *unequivocally* that the layout instructions for displaying the supplemental content *vis a vis* the video content are obtained from the target resource. This is an important aspect of the invention of Shoff as “embedding the layout instructions in the interactive context *advantageously* turns the control of the display to the content developers.”

Modifying Shoff such that the interactive content is displayed *vis a vis* the broadcast content according to the user’s preference directly contravenes this objection. Indeed, it moves the layout preference from the content developers to the user. As such, it is directly contrary to the teachings of Shoff. Therefore, since formatting the broadcast and interactive content according to the user’s preferences is directly contrary Shoff, there can be no reason to modify Shoff in such a way. Accordingly, Applicants respectfully request the Examiner withdraw the rejection and allow the claims.

The Commissioner is hereby authorized to charge any additional fees associated with this communication to Deposit Account No. 50-4364.

Respectfully submitted

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